



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,229	04/20/2000	ROLF BRANDENBERGER	08846-076001	8809

7590 01/02/2002

ANDREW N PARFOMAK
FISH & RICHARDSON
45 ROCKEFELLER PLAZA
SUITE 2800
NEW YORK, NY 10111

EXAMINER

SINGH, SUNIL

ART UNIT	PAPER NUMBER
----------	--------------

3673

DATE MAILED: 01/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/508,229

Applicant(s)
Brandenberger et al.

Examiner
Sunil Singh

Art Unit
3673



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 9, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) 9 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Art Unit: 3673

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8 and 10-17 are, drawn to a cladding construction for a partially overhanging substrate and method of providing the same.

Group II, claim(s) 9 is, drawn to a composite waterproofing system for application to surfaces.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I is drawn to a cladding construction and method of providing the same for a partially overhanging substrate, wherein the construction comprises in sequence, a drainage means, a waterproofing membrane sprayed onto the drainage means and a layer of concrete. Group II is drawn to a composite waterproofing system for application to surfaces, wherein the system comprises drainage means and a sprayed waterproof

Art Unit: 3673

membrane, Group II clearly does not relate to cladding construction for a partially overhanging substrate wherein the elements of the cladding construction are placed in a sequence as set forth in the claims of Group I.

3. Claim 9 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

5. Newly submitted claims 18-20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 18-20 are drawn to the details of the drainage means wherein such details are not required by "drainage means" recited in claims 1 and 8.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Art Unit: 3673

Specification

6. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to "Microfiche Appendix" and the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-References to Related Applications.
- © Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Microfiche Appendix" (see 37 CFR 1.96).
- (e) Background of the Invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (I) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing (see 37 CFR 1.821-1.825).

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

8. The following title is suggested: WATERPROOF CLADDING CONSTRUCTION AND METHOD OF PROVIDING THE SAME

Art Unit: 3673

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 lines 2-4, "to that side ... layer" is confusing because it is not clear what "to that side" actually means.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1,2,6,7,8,10 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Pulkkinen (US 4695188).

Art Unit: 3673

Pulkkinen discloses a cladding on a partially-overhanging substrate which comprises, in sequence starting from the substrate; a drainage means (15); a waterproofing membrane (12) and a layer of reinforcing (fibre) concrete (11). The substrate is given an initial layer of concrete (13). With regards to claim 16, concrete (13) is considered as the fastening means used to secure said waterproofing membrane (12) to said drainage means (15).

With regards to claims 8, 10, 14, 15 and 17, the recited method steps are considered to be inherent to the use of the apparatus disclosed by Pulkkinen.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-8 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wipo document (98/24738) in view of Bernold (US 3858400).

Wipo document '738 discloses a cladding on a partially overhanging substrate which comprises in sequence starting from the substrate, an initial layer of concrete, a waterproofing membrane which has been applied thereto by spraying; and a layer of concrete. The waterproofing membrane is a plastics material with anchoring means for subsequent layers (see page 3). The waterproofing membrane is a layer of coalesced particles of thermoplastic polymer (see pages 2-3). The layer of concrete is applied by spraying (see page 4).

Art Unit: 3673

Wipo document '738 discloses the invention substantially as claimed. However, Wipo document '738 is silent about including drainage means, wherein the drainage means is a plastics mesh. Bernold teaches a cladding construction that includes a drainage means, wherein the drainage means is a plastics mesh (5,18). It would have been considered obvious to one of ordinary skill in the art to modify Wipo '738 to include the drainage means taught by Bernold in order to provide an added waterproofing means thus further preventing water from running into the tunnel or like members.

With regards to claim 16, member (5) of Bernold reference is considered as the fastening means used to secure the waterproofing membrane to said drainage means (18).

With respect to claims 8, 10-14 and 17, the recited method steps are considered to be inherent to the use of the apparatus as disclosed by Wipo document '738 in view of Bernold.

With regards to claims 7 and 15, the Wipo document '738 (once modified) is silent about the sprayed concrete comprising reinforcing fibres. However, Wipo document '738 teaches sprayed concrete comprising reinforcing fibres is well known (see page 1 lines 5-15). It would have been considered obvious to one of ordinary skill in the art to further modify the (once modified) Wipo'738 to include reinforcing fibres in the sprayed concrete as is taught by the prior art in order to increase the bearing strength of the cladding construction.

Response to Arguments

Art Unit: 3673

15. Applicant's arguments filed 10/09/01 have been fully considered but they are not persuasive. Applicant argues that WO 98/24738 does not mention any "drainage means". This is not concurred with. The examiner would like to point to page 1 paragraph 2 of WO 98/24738 wherein it discusses means of achieving waterproofing can be accomplished by either providing "drainage means" or by providing a waterproof membrane sandwich between concrete layers. Therefore, it would have been considered obvious to one skilled in the art to provide both means of waterproofing in order to ensure there is no leaking.

Applicant argues that Bernold does not teach a drainage means, particularly a plastic mesh connected to a sump. It should be noted that these limitations are far more limiting than the claimed subject matter. Further, applicant argues that WO 98/24738 in view of Bernold does not teach the innovative "sandwich" drainage means, specifically the "multi-layered structure comprising a plastic mesh, intermediate at least partially waterproof layer and at least one fibrous layer". Once again, it should be noted that these limitations are far more limiting than the claimed subject matter.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.


Art Unit: 3673

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell, can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

SS

12/31/2001


DAVID BAGNELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600